

REMARKS

This is in response to the Office Action that was mailed on August 8, 2005. Minor idiomatic errors are corrected in the specification. New claim 38 is based upon claim 1 as it was in the Amendment filed 12 October 2004, modified to recite preferred substrates, as disclosed for instance on page 34, lines 2-11, page 35, line 13 – page 36, line 3, and page 38, lines 21-26. In this connection, it is pointed out that the working Examples from line 27 on page 96 through line 24 on page 111 disclose embodiments of the invention using as substrates cyclohexane, adamantanol, adamantane, para-xylene, meta-xylene, beta-picoline, 1,2,4,5-tetramethylbenzene, para-tertiary-butyltoluene, fluorene, and diphenylmethane. No new matter is introduced by this Amendment. With this Amendment, claims 1-3, 18, and 38 are pending in the application.

In the paragraph bridging pages 2-3 of the Office Action, objection was raised to the specification as containing new matter. The Examiner argues that characterizing the C₄₋₁₆cycloalkane as a substrate constitutes new matter. That object is not understood. The specification as filed stated:

The species of a substrate is not particularly limited, and includes various substrates ... such as a hydrocarbon As the hydrocarbon, there may be mentioned ... a cycloalkane The cycloalkanes include ... preferably C₄₋₁₆cycloalkanes.

Page 23, line 23 through page 25, line 13. Thus, the specification herein clearly and expressly teaches that – in the context of the present invention – C₄₋₁₆cycloalkanes are ***not products*** and that instead they are ***substrates***.

Claims 1-3 and 18 were rejected under the first paragraph of 35 U.S.C. 112 as failing to define the invention properly. The rejection is respectfully traversed. The essence of the rationale for the rejection is embodied in the Examiner's contention that "there is not mention anywhere in applicants' specification of only using the hydrocarbon or the chain ether as the solvent for the crystallization of the imide compound from a reaction mixture obtained by an

oxidation reaction of only a monocyclic C₄-C₁₆cycloalkane substrate". Applicants maintain that the disclosure in the paragraph bridging pages 48-49 of the specification – "When the reaction product is a low or weakly polar compound (such as an oxidation reaction product of a monocyclic C₄₋₁₆cycloalkane), it is preferred that a hydrocarbon or chain ether is employed as the solvent for crystallization" – constitutes adequate basis for reciting a hydrocarbon or chain ether as a solvent with an oxidation reaction product of a monocyclic C₄₋₁₆cycloalkane in the claims.

Withdrawal of the rejection of record, and passage of this application to Issue, is respectfully solicited.

FORICHER. The Foricher reference does not disclose a reaction involving a substrate of the type required by claims 1-3, 18, and 38 herein. The special substrates of Foricher, that is, isoprenoids having an allylic hydrogen, are not identical to – and indeed have no meaningful relationship in chemical structure or properties to – the substrates recited in claims 1-3, 18, and 38 herein, none of which is an isoprenoid having an allylic hydrogen atom. The present invention differs remarkably from Foricher with respect not only to the substrate but also to reaction mechanisms. Accordingly, the present invention is clearly patentable over the Foricher disclosure.

The Examiner is invited to contact Richard Gallagher (Reg. No. 28,781) at (703) 205-8008 with any questions.

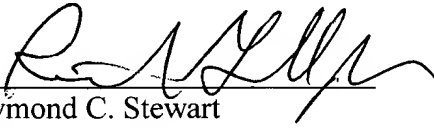
Application No. 09/980,588
Amendment dated December 8, 2005
Reply to Office Action of August 8, 2005

Docket No.: 2224-0194P

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fee required under 37 CFR 1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

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